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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,094	06/01/2001	Ryohei Tsukamoto	14648	2445

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EXAMINER

THOMPSON JR, FOREST

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,094

Applicant(s)

TSUKAMOTO, RYOHEI

Examiner

Forest Thompson Jr.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/16/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 have been examined.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119 (a)-(d), which papers have been placed of record in the file. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 C.F.R. 1.55. See MPEP 201.15.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. MPEP 2106.IV.B.1 states:

(Remainder of page intentionally left blank)

1. Nonstatutory Subject Matter

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claim 18 states "A computer program for use in a user terminal" in line 1. This claimed aspect is descriptive material and nonstatutory subject matter per MPEP Section 2106.IV.B.1 (see above). Therefore, claim 18 is rejected. To expedite prosecution, examiner has identified prior art to reject the claimed aspects that encompasses a computer program stored on a computer or computer device.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-2, 7-11, 13-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gazzuolo (U.S. Patent No. 6,546,309).

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim 1: Gazzuolo teaches:

- a user image database (col. 1 line 63 – col. 2 line 12);
- user image managing means for acquiring an image of a user of the Internet boutique system from outside thereof, and recording and managing the image of the user in said user image database (col. 3 line 61 – col. 4 line 10; col. 9 line 49 – col. 10 line 11);
- coordinating means for displaying the image of a commodity selected by the user from the images of commodities for sale in the Internet boutique system, in combination with said image of the user (fig. 6 [648]);
- purchase processing means for performing a process of purchasing a commodity confirmed by said coordinating means and determined to be purchased by said user (col. 12 lines 4-13);
- a purchased commodity database (col. 13 lines 7-11); and
- purchased commodity managing means for recording and managing data of the commodity determined to be purchased by said user, in said purchased commodity database (col. 3 line 44 – col. 4 line 22).

Claim 2: Gazzuolo teaches:

- commodity registering means for allowing a seller to register the image of a commodity for sale in the Internet boutique system (col. 2 lines 34-45), which is encompassed in the teaching *The virtual fitting room preferably operates in an Internet*

environment, although it is equally usable in desktop computer or PDA format. In a preferred embodiment of the virtual fitting room of the present invention, a user, prior to entering the virtual fitting room of the present invention, visits a participating manufacturer's web site to select the clothing she would like to virtually "try-on". The user's selected garments are placed in a virtual "shopping cart". Once the user has selected all of the garments she would like to try-on, she brings her shopping basket into the virtual fitting room by selecting a button on the manufacturer's web site.

- a commodity image database (col. 1 line 63 – col. 2 line 12); and
- commodity image managing means for classifying the images of commodities for sale which are registered by said commodity registering means according to at least type, design, and color, and recording and managing the classified images of commodities in said commodity image database (col. 7 line 31 – col. 10 line 37).

Claim 7: Gazzuolo teaches said user image managing means comprises means for extracting an image in a prespecified range from the acquired image of the user, and recording and managing the extracted image in said user image database (col. 7 lines 44-58).

Claim 8: Gazzuolo teaches:

- a communicating means for transmitting and receiving the image of a commodity for sale in an Internet boutique system and data of a user, via the Internet to and from a user terminal connected to the Internet (fig. 7 [700-722]); and

- a purchased commodity database (col. 13 lines 7-11); and
- purchased commodity managing means for recording and managing data, which is included in the data received by said communicating means, of a commodity determined to be purchased by a user of the Internet boutique system, in said purchased commodity database (col. 3 line 44 – col. 4 line 22).

Claim 9: Claim 9 is written as a server and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 10: Gazzuolo teaches program managing means for transmitting, from said communicating means, a coordination program for combining the image of the commodity for sale in the Internet boutique system with an image of the user to confirm how the combined images are coordinated with each other (col. 12 lines 4-11).

Claim 11: Gazzuolo teaches:

- a user image database (col. 1 line 63 – col. 2 line 12); and
- user image managing means for acquiring an image of the user from outside of the Internet boutique system, and recording and managing the image of the user in said user image database (col. 3 line 61 – col. 4 line 10; col. 9 line 49 – col. 10 line 11).

Claim 13: Gazzuolo teaches authenticating means for authenticating the user when the user uses said user image database via said user image managing means from outside of said server (col. 12 lines 27-39).

Claim 14: Gazzuolo teaches:

- a user image database (col. 1 line 63 – col. 2 line 12);
- user image managing means for acquiring an image of a user of an Internet boutique system from outside thereof, and recording and managing the image of the user in said user image database (col. 3 line 61 – col. 4 line 10; col. 9 line 49 – col. 10 line 11);
- coordinating means for displaying the image of a commodity selected by the user from the images of commodities for sale in the Internet boutique system, in combination with said image of the user (fig. 6 [648]);
- purchase processing means for performing a process of purchasing a commodity confirmed by said coordinating means and determined to be purchased by said user (col. 12 lines 4-13); and
- communicating means for transmitting and receiving the images of commodities for use in the Internet boutique system, information of the user, and information of the commodity determined to be purchased, via the Internet to and from a server (fig. 7 [700-722]).

Claim 15: Claim 15 is written as a user terminal and contains the same limitations as claim 7; therefore, the same rejection is applied.

Claim 16: Claim 16 is written as a user terminal and contains the same limitations as claim 13; therefore, the same rejection is applied.

Claim 18: Claim 18 is written as a computer program and contains essentially the same limitations as claim 1; therefore, the same rejection is applied.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gazzuolo as applied to claim 1 above, and further in view of Kawahara .

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Claim 3: Gazzuolo does not explicitly teach means for simultaneously displaying a first view of a plurality of images of commodities for sale in the Internet boutique system, and a second view of a combination of the image of the selected commodity and the image of the user, separately from each other. However, Kawahara does teach means for simultaneously displaying a first view of a plurality of images of commodities for sale in the Internet boutique system, and a second view of a combination of the image of the selected commodity and the image of the user, separately from each other (Figure 1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Gazzuolo to explicitly display a first view of a plurality of images of commodities for sale in the Internet boutique system, and a second view of a combination of the image of the selected commodity and the image of the user, separately from each other, as taught by Kawahara, for the motivation of providing comparisons of image combinations to the user.

Claim 4: Gazzuolo does not explicitly teach said second view includes a portion at a given ratio of horizontal and vertical dimensions, and said first view is disposed in an area other than said second view. However, Kawahara teaches said second view includes a portion at a given ratio of horizontal and vertical dimensions, and said first view is disposed in an area other than said second view (Figure 1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify

the teaching of Gazzuolo to explicitly teach said second view includes a portion at a given ratio of horizontal and vertical dimensions, and said first view is disposed in an area other than said second view, as taught by Kawahara, for the motivation of providing image combinations to the user that represent realistic representations of the fit for the combination of the commodity as on the user.

Claim 5: Gazzuolo does not explicitly teach said first view includes a pair of portions displayed on opposite sides of said second view, nor said coordinating means comprises means for displaying a plurality of images of commodities of different types respectively in said portions of the first view. However, Kawahara teaches said first view includes a pair of portions displayed on opposite sides of said second view, and said coordinating means comprises means for displaying a plurality of images of commodities of different types respectively in said portions of the first view (pg. 3 section 3.1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Gazzuolo to explicitly include in said first view a pair of portions displayed on opposite sides of said second view, and display a plurality of images of commodities of different types respectively in said portions of the first view, as taught by Kawahara, for the motivation of providing choices of image combinations to the user that represent realistic representations of the fit for the combination of the commodity as on the user so that the user may purchase the commodities.

Claim 6: Gazzuolo teaches said given ratio of horizontal and vertical dimensions is substantially equal to a ratio horizontal and vertical dimensions of a human body (col. 3 lines 4-18).

8. Claims 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gazzuolo as applied to claims 8 and 14 above, and further in view of Official Notice.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim 12: Gazzuolo teaches acquiring an image of a user of the Internet boutique system from outside thereof, and recording and managing the image of the user in said user image database (col. 3 line 61 – col. 4 line 10; col. 9 line 49 – col. 10 line 11).

Gazzuolo does not explicitly teach said user image managing means comprises means for extracting an image in a prespecified range from the acquired image of the user.

However, Official Notice is taken that extracting an image in a prespecified range from an acquired image was old and well known in the art at the time the invention was made. Many graphics software programs have been available for many years for capturing and saving whole or parts of graphics images on a computer system. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Gazzuolo to explicitly extract an image in a prespecified range from the acquired image of the user and save it, as taught by old and well known art, for the motivation of providing the customer/user with desirable functionality to assist him in making purchase decisions.


Claim 17: Gazzuolo does not explicitly teach downloading means for downloading, from said communicating means, a coordination program to realize said user image managing means, said user image database, and said coordinating means. However, Official Notice is taken that downloading software programs was old and well known in the art at the time the invention was made. This capability has been a common function and practice of Internet and other network users since the early days of the Internet (e.g., at least since the mid-1990s). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Gazzuolo to explicitly teach a downloading means, as taught by old and well known art, for the motivation of providing functionality to the user terminal for the Internet boutique system.

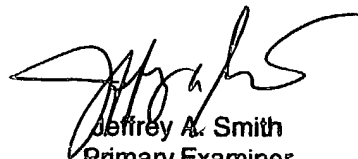
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT 
07/26/2004


Jeffrey A. Smith
Primary Examiner